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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,104	11/04/2003	Gregory B. Altshuler	105090-0129	6794

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EXAMINER
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JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/702,104

Applicant(s)

ALTSHULER ET AL.

Examiner

Henry M Johnson, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-17,19-23 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-14,16,17,19-23 and 55 is/are rejected.
- 7) ☒ Claim(s) 10 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/7/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 060704 120604.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Claims 3, 18, 24 and 26-54 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 13, 2005.

Claim 25 is withdrawn by the examiner, as it is dependent on a withdrawn claim.

### ***Claim Objections***

Claim 21 is objected to because of the following informalities: the skin-contacting surface is cited as a plate, defined by the dictionary as "A smooth, flat, relatively thin, rigid body of uniform thickness". This conflicts with the independent claim of a protuberance. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

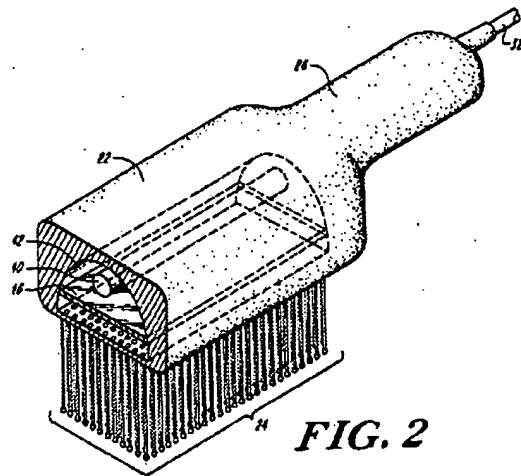
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-7, 13, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,300,097 to Lerner et al. Lerner et

al. teach a handheld device for treating a skin condition with optical fiber protuberances for contacting the skin and an optical source (Fig. 2, # 40) positioned to provide radiation via the fiber optics. The optical fibers are interpreted as forming a brush. The fibers are capable of providing force to the skin.



Regarding claims 6 and 7, Lerner et al.

disclose the radiation provided may be from 1-10 mW/cm<sup>2</sup> or from 30-1000 mw/cm<sup>2</sup> (col. 2, lines 47-49).

Regarding claim 13, the source is controlled by a timer with no disclosed pulsing, making the radiation continuous.

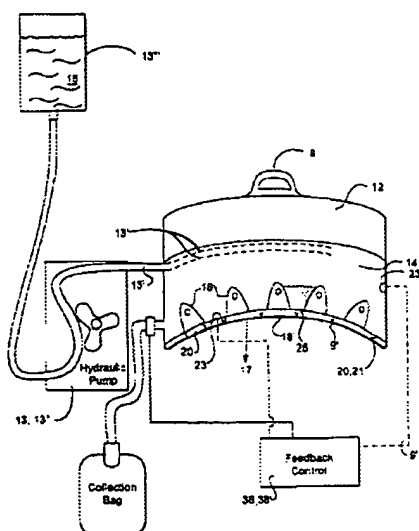
Regarding claims 19-20, the source is within the handheld unit (Fig. 2).

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Claims 1, 8, 9, 11, 14 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,358,503 to Bertwell et al. Bertwell et al disclose an apparatus for photo-thermal treatment of an area of the skin. It includes a plurality of juxtaposed diodes defining a treatment area. Each diode has a longitudinal axis and is capable of projecting a non-coherent cone of light when energized (Col. 2, lines 60-65). The diodes are arranged as an array and protrude from the mounting plate and each deliver radiation (Fig. 2). The diodes act as a heat sink for absorbing the heat generated by each resistor for application to the treatment site by the diodes (Col. 3, lines 15-18).

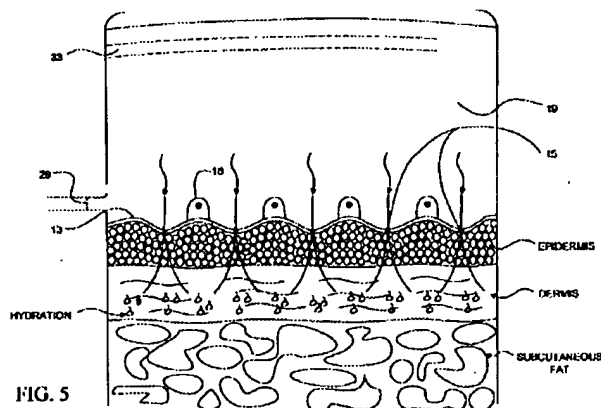
Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,930,504 to Diamantopoulos et al. Diamantopoulos et al. teach a handheld probe with multiple superluminous diodes (Fig. 5) for tissue biostimulation. The diodes are interpreted as protuberances. The diode cluster (Fig. 6) includes four different wavelengths (Col. 6, lines 45-50).

Claims 1, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,350,276 to Knowlton. Knowlton discloses an apparatus for treating tissue using energy sources that may be light (Col. 7, lines 55-56). Figure 5 (herein), from a cross-referenced



(and  
incorporated)  
Knowlton  
patent

(6,425,912), teaches energy sources (Fig. 5, # 18) that conform to the skin, the irregular surface forming



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protuberances. Knowlton teaches cooling of the sources and tissue using a liquid ( Fig. 2B, # 15) that can be in a liquid or gaseous state, or may exist in two or more phases and may undergo a phase change as part of its cooling function (Col. 5, lines 29-35), such as melting or evaporation (whereby heat is absorbed by the fluid as a latent heat of fusion or evaporation).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,300,097 to Lerner et al. as applied to claim 1 above, and further in view of U.S. Patent 6,572,637 to Yamazaki et al. Lerner is discussed above, but does not teach a means for detecting contact of the device with a treatment area. Yamazaki et al. disclose a handheld laser skin treatment device that includes a microswitch responsive to adjuster's touching the skin for making the electric power supply to turn on, and responsive to adjuster's leaving the skin for making the electric power supply to turn off (Col. 3, lines 24-27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the contact sensor as taught by Yamazaki et al. in the invention of Lerner et al. to avoid radiation of unintended areas.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,300,097 to Lerner et al. as applied to claim 1 above, and further in view of U.S. Patent 5,445,608 to Chen et al. Lerner et al. is discussed above and further teaches the application of treatment substances prior to the radiation (Col. 3, lines 10-15). Chen et al. teach a device for

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photodynamic therapy using optical sources (abstract). Chen et al. further teaches the concept of introducing the treatment agent via the apparatus wherein the photoreactive agent can then be caused to flow through a lumen so that it perfuses the internal, in vivo treatment site (Col. 4, lines 13-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an agent delivery means as taught by Chen et al. in the invention of Lerner et al. as Lerner et al. clearly cites such agents are often required.

#### ***Allowable Subject Matter***

Claims 10 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Henry M. Johnson, III  
Patent Examiner  
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